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| 09/607,553 | 06/29/2000 | Greg Lane | 11712/1 | 8510 |

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EXAMINER

EDELMAN, BRADLEY E

| ART UNIT | PAPER NUMBER |
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2153

DATE MAILED: 09/17/2003

3

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/607,553

Applicant(s)

LANE, GREG

Examiner

Bradley Edelman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,13-16,20-24 and 26 is/are allowed.
- 6) ☒ Claim(s) 2-11,17-19 and 25 is/are rejected.
- 7) ☒ Claim(s) 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 June 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

This is a first office action on the merits of this application. Claims 1-26 are presented for examination.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 3-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In considering claim 3, line 8 of the claim recites, "downloading the limited functionality object." However, the phrase "the limited functionality object" lacks sufficient antecedent basis in the claim. Correction is required.

Claims 4-8 depend from claim 3 and are thus rejected as well.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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2. Claims 18 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Hurley (U.S. Patent No. 5,984,508).

In considering claim 18, Hurley discloses a computer-implemented method for enabling a user to obtain a program object for use in a host application running on a client computer, the client computer coupled to a server computer via a network, the method comprising the steps of:

(a) downloading a limited functionality object ("demonstration software") from the server computer to the client computer;

(b) receiving a request at the server computer from the client computer to obtain a full functionality object ("full access") corresponding to the limited functionality object; and

(c) providing a set of program parts from the server computer to the client computer ("obtain[ing] an access code from the vendor"), the set of program parts when combined with the limited functionality object creating a unique fully functionally object.

(Abstract).

In considering claim 19, Hurley further discloses recording in a database at the server computer the identity of the user associated with the request (col. 5, lines 4-10).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 2, 9-11, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanford (U.S. Patent No. 6,536,039), in view of Chen et al. (U.S. Patent No. 6,496,979, hereinafter "Chen").

In considering claim 2, Sanford discloses a computer-implemented method for enabling a user ("user") to obtain a program object ("program module") for use in a host application ("program") running on a client computer without halting or restarting the host application ("during a program run"), the client computer coupled to a server computer ("server") via a network (Abstract; col. 3, lines 35-50), the method comprising the steps of:

(a) enabling the user to select a program object (col. 4, lines 44-46, "the user chooses one of these listed new program modules residing on the designated information site");

(c) downloading the object from the server computer to the client computer (col. 4, lines 46-47, "data server downloads the chosen program modules from the designated information site to the PC hard disk drive"); and

(d) integrating the object in the host application without halting or restarting the host application (col. 4, lines 48-49; col. 6-8, "the program then runs the newly downloaded replacement or additional program module from the PC hard disk drive," wherein "program modules downloaded during both the current and previous program runs can be used during the current program run").

However, Sanford fails to disclose that the program object is customized at the server according to a rule-set in a program object template corresponding to the selected program object to create a unique object. Nonetheless, customizing computer programs and applications according to a rule-set in a program object downloading system is well known, as evidenced by Chen. In a similar art, Chen discloses a system for downloading and installing software packages to mobile devices, wherein the software packages are customized according to mobile device type and ID (col. 8, lines 28-40). Thus, given the teaching of Chen, a person having ordinary skill in the art would have readily recognized the desirability and advantages of customizing the program objects using a rule-set and template, as taught by Chen, so that users could obtain software tailored to their specific needs (i.e. if they are using a mobile device). Therefore, it would have been obvious to include the customization feature taught by Chen in the software downloading and upgrading system taught by Sanford.

In considering claim 9, Sanford discloses a computer-implemented method for enabling a user ("user") to obtain a program object ("program module") for use in a host application ("program") running on a client computer coupled to a server computer ("server") via a network (Abstract; col. 3, lines 35-50), the method comprising the steps of:

(a) enabling the user to select a program object (col. 4, lines 44-46, "the user chooses one of these listed new program modules residing on the designated information site");

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(c) downloading the object from the server computer to the client computer (col. 4, lines 46-47, "data server downloads the chosen program modules from the designated information site to the PC hard disk drive"); and

(d) integrating the object in the host application (col. 4, lines 48-49; col. 6-8, "the program then runs the newly downloaded replacement or additional program module from the PC hard disk drive,").

However, Sanford fails to disclose that the program object is customized at the server according to a rule-set. Nonetheless, customizing computer programs and applications according to a rule-set is well known, as evidenced by Chen. In a similar art, Chen discloses a system for downloading and installing software packages to mobile devices, wherein the software packages are customized according to mobile device type and ID (col. 8, lines 28-40). Thus, given the teaching of Chen, a person having ordinary skill in the art would have readily recognized the desirability and advantages of customizing the program objects using a rule-set and template, as taught by Chen, so that users could obtain software tailored to their specific needs (i.e. if they are using a mobile device). Therefore, it would have been obvious to include the customization feature taught by Chen in the software downloading and upgrading system taught by Sanford..

In considering claim 10, as understood, Sanford further discloses integrating the program object into the host application without halting or restarting the host application, wherein the program object is a fully functional object (col. 4, lines 48-49; col. 6-8,

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wherein "program modules downloaded during both the current and previous program runs can be used during the current program run" and wherein such programs are therefore fully functional).

In considering claim 11, although the system taught by Sanford and Chen teaches substantial features of the claimed invention, it fails to discuss storing the identity of the user in a sales database at the server, the identity being associated with the unique object in the sales database. Nonetheless, Examiner takes official notice that maintaining sales databases for users who have downloaded software over the network is well known in the art. Given this knowledge, a person having ordinary skill in the art would have readily recognized the desirability and advantages of recording in a sales database the user ID of the user downloading software updates in the system taught by Sanford and Chen, so that the software developers can be compensated for their product. Therefore, it would have been obvious to include a well known sales database in the software distribution system taught by Sanford and Chen.

Claim 25 contains no further substantial limitations over claims 2 and 11, and is thus rejected for the same reasons stated previously.

4. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sanford.

In considering claim 17, Sanford discloses a computer-implemented method for enabling a user to obtain a program object for use in a host application running on a

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client computer, the client computer coupled to a server computer via a network, the method comprising the steps of:

(a) creating a limited functionality object, and (b) downloading the limited functionality object to the client computer (col. 2, lines 8-11, wherein the original program, without the latest updates, is a limited functionality object);

(c) receiving a request at the server computer from the client computer to obtain a full functional object corresponding to the limited functionality object (col. 2, lines 53-57, wherein the client sends a request to the server to obtain the new modules to create a full functional object); and

(d) providing a set of program parts (i.e. the new program modules) from the server computer to the client computer, the set of program parts when combined with the limited functionality object creating the full functionality object (col. 2, lines 57-62, wherein the new program modules are added to the original, limited program object, to create a fully functional object).

However, Sanford does not disclose (1) that the original, limited functionality object is created at the server and is sent to the client from the server, and (2) recording in a database at the server computer the identity of the user associated with the request. Nonetheless, Examiner takes official notice that both of these features are well known in the computer networking art, and would be obvious to include in the system taught by Sanford. Regarding (1), Examiner takes official notice that it is well known for clients to download software from servers. Thus, given this knowledge, it would have been obvious to a person having ordinary skill in the art to allow users in the system

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taught by Sanford to download the initial program from server, instead of installing it from a CD as taught by Sanford, to avoid the need to send physical CDs through the mail, thus expediting the software installation process. Regarding (2), as discussed previously, Examiner takes official notice that it is well known to record the names of users who download software and files from the Internet in a database. It would thus have been obvious to a person having ordinary skill in the art to record the identity of users who download software in the system taught by Sanford, so that users can be charged a fee for such download, thereby allowing the software creators to collect compensation for their products.

Allowable Subject Matter

5. Claims 1, 13-16, 20-24, and 26 are allowed.
6. Claim 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: regarding these claims, the prior art of record fails to disclose or render obvious the all of the limitations described by the claims, as read in view of Applicant's specification.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Edelman whose telephone number is (703) 306-3041. The examiner can normally be reached on Monday to Friday from 8:30 AM to 5:00 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on (703) 305-4792. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

For all After Final papers: (703) 746-7238.

For all other correspondences: (703) 746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

BE
September 8, 2003


GLEN B. BURGESS
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